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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,342	04/02/2004	Murray S. Toas	D0932-00457 [I-8882]	3304

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EXAMINER

DIXON, MERRICK L

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/817,342	Applicant(s) TOAS ET AL.	
	Examiner Merrick Dixon	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


MERRICK DIXON
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1,2,3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Qi(US 6851941 B2).

The cited reference teaches the claimed invention including a process for making shiplap edges in duct board comprising molding same edge and machining the resulting molded shiplap edge to a thickness- col 1, lines 15-27; col 2, lines 55-58; col 3, lines 24-32; col 6, lines 5-12; figs 1 and 10. concerning claim 2, the reference teaches forming increased density into the product by virtue of compressing the product with shoe(50)- col 6, lines 5-12. concerning claim 3, the reference teaches edge compression by the shoe(50) in col 6, lines 8-12. concerning claim 10, the reference teaches forming additional shiplap edges in fig. 10.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4,5,6,7,8,9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qi(US 6851941 B2) in view of Luongo(US 6391958 B1). The primary reference to Qi was discussed above. Inter alia. Although same reference substantially teaches the claimed process, the examiner was unable to find express teachings of the notoriously well known step (in the instant art) of grinding its product during its patented process. The secondary reference to Luongo, however, teaches that it is known in the art to machine (grind) duct board products, as taught by the primary reference, during its production. It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teaching to the secondary reference and utilize and manipulate such notoriously well known process operations, such as grinding, during the primary reference's process, in the absence of unexpected results. Such a combination would have been obvious motivated by the desire to cut production cost – col 7, lines 20-24..Concerning claim 13, the secondary reference teaches grinding steps as discussed above. Concerning claims 7-9, although and it is submitted, the recited apparatus limitations do not affect the instant question for patentability, i.e., such question concerns process limitations(Ex parte Pfeiffer, 1962 C.D. 408(1961)), the primary reference however teaches adjustable device means in col 4, lines 10-30; col 3, lines 3-10. Likewise and concerning claims 4 and 5, it has long been held that to be entitled to weight in process claims, the recited structure limitations must affect the

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method in a manipulative sense and not amount to merely claiming its use, as in the instant case. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Such claimed product thickness, are thus of no patentable consequences to such question. This position also applies to the claimed device limitations, claims 7-9, as is also discussed above. The primary reference, however, teaches a manipulated product thickness(128) via press (50)- see figure 10.

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Applicant's arguments filed 10-19-05 have been fully considered but they are not persuasive. Applicants argue that by the examiner admission on page 3 of the office action, the 102, as proposed is improper. Specifically, the office admits, applicants argue, the reference fails to teach a grinding step. The examiner respectfully remind applicants that claims 1,2,3 and 10 does not requires, "grinding" but machining the edge as taught by Qi. Claim 13 requires the machining step comprising grinding. Accordingly, the secondary reference to Loungo was employed to teach this notoriously well known step in the instant art. Applicants argue the cited references fail to teaches this well known grinding step. The examiner submits that such grinding step is indeed notoriously well known and readily admitted on page 1, line 27- page 2, line 2 of the instant application's specification. Accordingly, such grinding step would have been obvious for reasons including same step being notoriously well known in the instant art.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's**

personal fax number should be in draft-forms and will be treated as informal.

Same facsimiles will not be entered in the related applications unless

otherwise agreed and noted by the examiner.

The fax number for all other fascimile is 571-273-8300.

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Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).

Status inquiries for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197**.

Any questions concerning the instant communication should be directed to Examiner Dixon, at 571-272-1520, Mondays, Wednesdays and Thursdays, between 12 noon and 8 PM, eastern time .

A handwritten signature in black ink, appearing to read 'Merrick Dixon', with a long horizontal flourish extending to the right.

Merrick Dixon

Primary Examiner

Group 1700